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PATENT
Attorney Docket No. 08048.0032

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:) Group Art Unit: 1615
Jean-Louis H. GUERET)
Application No.: 09/779,095) Examiner: Isis A. D. GHALI
Filed: February 8, 2001) Confirmation No.: 1674
For: COMPOSITE STRUCTURE) **Mail Stop Appeal Brief-Patents**
HAVING AN ADHESIVE MATRIX)
CONTAINING ONE OR MORE)
ACTIVE AGENTS)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on June 28, 2006.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Notice of Appeal Fee \$ 0.00 (Paid June 28, 2006)

Extension Fee (if any) \$ 0.00

Total Fee Due \$500.00



☒ Enclosed is a check for \$500.00 to cover the above fee.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 28, 2006

By: 

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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed June 28, 2006, and further to Rule 41.37,
Appellant presents this brief and enclose herewith a check for the fee of \$500.00
required under 37 C.F.R. § 1.17(c).

This Appeal responds to the March 28, 2006, final rejection of claims 1, 5-30, and
35-65. If any additional fees are required or if the enclosed payment is insufficient,
Appellant requests that the required fees be charged to Deposit Account No. 06-0916.

08/29/2006 JADD01 00000010 09779095

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Real Party In Interest

L'OREAL is the real party in interest.

Related Appeals and Interferences

An appeal to the Board of Patent Appeals and Interferences is pending in U.S. application number 10/107,410. Application number 10/107,410 was originally filed on March 28, 2002 and has the same inventor as the present application. In addition, claims of that application were cited in a prior provisional obviousness-type double patenting rejection in an Office Action dated July 20, 2005.

The same Shlenker reference that has been applied by the Examiner in claim rejections for the present application has also been applied in the 10/107,410 application.

Status Of Claims

Claims 1, 5-30, and 35-65 are pending. Claims 1, 27, 54, 55, 56, and 61 are independent. Each of the rejections applied to those claims is at issue in this appeal.

All of pending claims 1, 5-30, and 35-65 stand finally rejected.

Status Of Amendments

No amendments have been filed subsequent to the final rejection.

Summary of Claimed Subject Matter

Independent Claim 1

The subject matter set forth in independent claim 1 relates to a composite structure for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5; Figs. 1-16.¹ The composite structure may include at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent and configured to be placed into contact with the surface region. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in the solvent. Page 7, lines 31-37. Further, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region. Page 8, lines 1-4.

Independent Claim 27

The subject matter set forth in independent claim 27 relates to a method of manufacturing a composite structure for cleaning, treating, and/or making up a surface region. Page 1, lines 3-5; page 5, lines 35-37; Figs. 1-16. The method may include coating a first non-adhesive layer with an adhesive matrix comprising a permanent adhesive, said adhesive matrix containing at least one active agent, the active agent being released when the composite structure is wetted by a solvent. Page 6, lines 1-7.

¹ In this Summary of Claimed Subject Matter, references to the text of the specification and drawings are provided to identify exemplary disclosure of certain subject matter. Those identifications should not be construed as imparting any limitation upon the scope of the claims.

The method may also include assembling together the coated first non-adhesive layer with a second non-adhesive layer such that the adhesive matrix is sandwiched between the first non-adhesive layer and the second non-adhesive layer and such that one of the first and second non-adhesive layers is configured to be placed into contact with the surface region. Page 6, lines 8-11. Further, the first non-adhesive layer and the second non-adhesive layer may be permanently bonded together by the adhesive matrix. Page 6, lines 11-12.

Independent Claim 54

The subject matter set forth in independent claim 54 relates to a composite structure for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in the solvent. Page 7, lines 31-37. In addition, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region. Page 8, lines 1-4. Further, the structure may be configured such that the adhesive matrix does not come into contact with the surface region. Page 8, lines 5-7.

Independent Claim 55

The subject matter set forth in independent claim 55 relates to a composite structure for treating, making up, and/or cleaning a surface region. Page 1, lines 3-5;

Figs. 1-16. The composite structure may include at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent. Page 7, lines 26-30; Page 10, line 36-Page 11, line 3. The composite structure may also include at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive. Page 7, lines 26-30 and 31. The two non-adhesive layers may be permanently bonded to the adhesive matrix and the adhesive matrix may contain at least one active agent that is soluble in the solvent. Page 7, lines 36-37. In addition, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, wherein the composite structure does not adhere to the surface region before being wetted by the solvent. Page 7, line 36-page 8, line 4.

Independent Claim 56

The subject matter set forth in independent claim 56 relates to a composite structure for treating, making up, and/or cleaning a surface region of the human body. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two support layers, at least one of the two support layers being permeable to a solvent, the support layers forming external faces of the structure. Page 7, lines 26-30. The composite structure may also include at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix. Page 7, lines 26-30 and 31. The adhesive matrix may contain at least one active agent that is soluble in the solvent. Page 7, lines 36-37. Further, the composite structure may be configured so that when the composite structure is wetted by the solvent, the active agent is

released from the adhesive matrix and diffuses towards the surface region. Page 7, line 36-page 8, line 4.

— **Independent Claim 61**

The subject matter set forth in independent claim 61 relates to a composite structure for treating, making up, and/or cleaning a surface region of the human body. Page 1, lines 3-5; Figs. 1-16. The composite structure may include at least two support layers and at least one adhesive matrix between the two support layers. Page 7, lines 26-28. The two support layers may be permanently bonded to the adhesive matrix. Page 7, line 31. In addition, the adhesive matrix may include magnetizable particles. Page 3, lines 27-28.

Grounds of Rejection

Claims 9, 11, and 14 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite;

Claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59, and 65 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,965,276 to Shlenker et al. ("Shlenker");

Claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shlenker in view of WO 98/18441 to Fowler et al. ("Fowler");

Claim 44 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Shlenker in view of U.S. Patent No. 6,338,839 to Auguste et al. ("Auguste"); and

Claims 12, 13, and 61-64 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shlenker in view of JP 04108710 to Yoko ("Yoko").

Argument

The rejection of claims 9, 11, and 14 under 35 U.S.C. 112, second paragraph should be reversed

With regard to the rejection of claim 9 under § 112, second paragraph, the Examiner stated that the phrase “freeze dried substances” in claim 9 is indefinite because “it is vague regarding which one of the recited moisture absorbing compounds is freeze dried.” Office Action at 4. Claim 9 recites “at least one moisture absorbing substance chosen from polyacrylates, silicas, cotton fibers . . . and freeze-dried substances.” “Freeze dried substances” is simply included in the listing of possible items that might be chosen as the at least one moisture absorbing compound. Since, as acknowledged by the Examiner, “‘freeze drying’ is a known process in the art,” (Id.) one of ordinary skill in the art would clearly understand the meaning of “freeze dried substances.” Therefore, claim 9 does not have any ambiguity. Accordingly, the rejection of claim 9 under § 112, second paragraph, should be reversed.

With regard to claim 11, the Examiner seems to allege that claim 11 improperly claims a range within a range. Specifically, the Examiner alleges that

the claim is vague because it recites “wetting agents” as well as other agents that read on wetting agent including glycerin and laponite. The claim recites “healing agent” as well as other agents that can read on healing agent, e.g., anti-inflammatory agents, antibacterial agents, and antifungal agents. Claim 11 recites “vascular protectors” as well as vitamin C and vitamin A that read on vascular protectors. The claim further recites “skin condition[ers]” . . . as well as moisturizers that read on skin conditioners.

Office Action at 4. Claim 11 recites a listing of active agents without causing any ambiguity or reciting a range within a range. Even if some of the listed items might be related, such relationships do not render the scope of the claim as indefinite. Therefore, the rejection of claim 11 under § 112, second paragraph, should be reversed.

The Examiner rejected claim 14 under § 112, second paragraph, based on an allegation that “vinyl” is not equivalent to PVP, PVA, acrylic polymers, etc., which are listed along with vinyl as possible components of the adhesive matrix. As stated in the specification on page 8, lines 18-19, PVP stands for polyvinyl pyrrolidone and PVA stands for polyvinyl alcohol. There is no ambiguity caused by listing vinyl along with other items that might include vinyl. Therefore, the rejection of claim 14 under § 112, second paragraph should be reversed.

The rejection of claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59, and 65 under 35 U.S.C. 102(e) should be reversed

Appellant respectfully submits that the rejection of claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59, and 65 under 35 U.S.C. § 102(e) based on Shlenker should be reversed because Shlenker fails to disclose each and every claimed limitation. For example, Shlenker fails to disclose

at least one adhesive matrix between the two non-adhesive layers, . . . the two non-adhesive layers being . . . bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent, wherein . . . when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region

as recited in independent claims 1, 54, and 55. Claim 56 includes similar recitations, but recites at least two “support” layers rather than at least two “non-adhesive” layers. Shlenker also fails to disclose an “adhesive matrix containing at least one active agent, the active agent being released when the composite structure is wetted by a solvent; . . . the first non-adhesive layer and the second non-adhesive layer being . . . bonded together by the adhesive matrix,” as recited in claim 27.

The Examiner cites Shlenker at col. 3, lines 53-55 and col. 5, lines 3-29 and apparently attempts to equate Shlenker's needle treatment layer with an adhesive matrix. Office Action at 6. Shlenker at col. 3, lines 53-55 refers to an adhesive backed patch including an antiseptic or cleansing agent contacting a needle or catheter piercing therethrough. The disclosed purpose of the adhesive of Shlenker's needle treatment layer is to form a sheath over a needle or other sharp object. Col. 5, lines 13-16. In one embodiment, Shlenker discloses a small adhesive backed patch or disc that can be attached to an area of skin through which a needle is set to penetrate. Col. 5, lines 34-36. Since Shlenker refers to the patch as being "adhesive backed" and "attached" to skin, the adhesive is not an adhesive matrix between two non-adhesive layers, as recited in claims 1, 54, and 55, and the adhesive is not an adhesive matrix between two support layers, as recited in claim 56. Further, the adhesive of Shlenker does not correspond to the adhesive matrix of claim 27, because Shlenker does not disclose non-adhesive layers bonded together by the adhesive.

Shlenker also fails disclose a "composite structure configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region," as recited in claims 1 and 54-56. Rather than disclosing such a configuration, Shlenker describes an arrangement in which a needle or other object pierces a membrane to cause a treatment substance to deactivate any harmful substances adhered to the needle. See col. 4, lines 59-61.

Additionally, Shlenker fails to disclose the following: "at least one adhesive matrix between the two non-adhesive layers, . . . the two non-adhesive layers being . . . bonded to the adhesive matrix," as recited in claims 1, 54, and 55; "at least one

adhesive matrix between the two support layers, . . . the two support layers being bonded to the adhesive matrix,” as recited in claim 56; and first and second non-adhesive layers “bonded together by an adhesive matrix,” as recited in claim 27. Indeed, Shlenker teaches away from bonding layers with an adhesive matrix and, instead, discloses several means for selectively bonding layers of a glove or condom at a cuff region and other areas to preserve chambers for a reservoir of material between the layers. See col. 8, lines 29-31; col. 12, lines 45-47. Shlenker specifically teaches discrete chambers between the layers. Col. 13, lines 19-21; col. 12, lines 52-53. Further, the cited reference teaches the use of a surfactant to prevent fusing of layers. Col. 12, lines 19-21. Thus, Shlenker fails to disclose all of the recitations of claims 1, 27, and 54-56.

For at least these reasons, claims 1, 27, and 54-56 are not anticipated by Shlenker. Claims 6-11, 14, 16, 18, 25, 26, 28-30, 39-41, 43, 45-48, 51-53, 57-59, and 65 each depend from one of claims 1, 27, and 54-56, and thus, are not anticipated by Shlenker for at least the same reasons that the claims from which they depend are not anticipated. Therefore, the section 102(e) rejection of claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59, and 65 should be reversed.

The rejection of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 under 35 U.S.C. § 103(a) should be reversed

Appellant respectfully submits that the rejection of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60, as well as the rejections of claims 12, 13, 44, and 61-64 (discussed below), under 35 U.S.C. 103(a) should be reversed because a case of *prima facie* obviousness has not been established with respect to those claims. To establish *prima*

facie obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine the references. In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant’s disclosure.” In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The combination of Shlenker and Fowler does not disclose or suggest all the recitations of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60

With regard to the rejection of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 under 35 U.S.C. § 103(a) based on Shlenker in view of Fowler, the Office Action fails to establish a *prima facie* case of obviousness at least because the applied references do not disclose or suggest each and every recitation of the claims. Claims 5, 15, 17, 19-24, 35-38, 42, 49, and 50 depend from claim 1, and claim 60 depends from claim 56. As discussed above, Shlenker fails to disclose or suggest all of the recitations of independent claims 1 and 56. Fowler also fails to disclose or suggest an adhesive matrix of any kind. Therefore, neither Shlenker nor Fowler nor any combination thereof discloses or suggests at least one adhesive matrix between two layers, the two layers being bonded to the adhesive matrix, as recited in claims 1 and 56. Accordingly, Fowler

does not correct the deficiencies of Shlenker with respect to independent claims 1 and 56. Therefore, the applied references fail to disclose or suggest all the recitations of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60, which each depend from either claim 1 or 56, and thus, the Examiner fails to establish a *prima facie* case of obviousness with respect to those claims.

In addition, the Examiner acknowledges that Shlenker

does not teach the water as a solvent to deliver the active agent; does not teach the outer layers made of non-woven material that have different properties; does not teach multiple layers having the same active agent; amount of moisture absorbing agents; or using the article for treating hair.

Office Action at 9. The Examiner attempts to remedy these acknowledged deficiencies by combining Fowler with Shlenker.

According to the Examiner, "Fowler is relied upon for the solely teaching [sic] of the mechanism of release of the active agent that is enclosed between two non-woven layers and released from an article upon wetting with water." Office Action, page 11, lines 7-9. Contrary to the Examiner's allegations, however, Fowler does not disclose or suggest active agent between two layers. Instead, Fowler teaches active agent on, or impregnated into, a substrate. Fowler, claim 10, lines 2-3. Since the Examiner's flawed allegation about Fowler appears to be the only reason for Fowler being relied upon, a case of *prima facie* obviousness has not been established with respect to claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60.

Because the Examiner has not established that the applied art discloses or suggests all of the features of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking.

For at least this reason, the § 103(a) rejection of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60, based on Shlenker and Fowler should be reversed.

There is no motivation, suggestion, or teaching to combine Shlenker and Fowler in a manner resulting in Appellant's claimed invention

In addition to the fact that the Office Action does not show that the features of claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 can be found in some combination of Shlenker and Fowler, a case for *prima facie* obviousness also has not been established with respect to these claims at least because the requisite motivation, suggestion, or teaching to combine the references is lacking. The Examiner alleges that

it would have been obvious to one having ordinary skill in the art . . . to provide the article disclosed by [Shlenker] . . . and use the non-woven materials disclosed in [Fowler] to form the outer layers that have different textures, motivated by the teaching of [Fowler] that article (sic) with that structure is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents.

Office Action at 10. However, the structural configuration of Shlenker is distinctly different from that of Fowler. For example, Shlenker, as discussed in detail above, discloses a "membrane of multi-layer construction includ[ing] one or more inner-layers, which serve as reservoirs for substances or agents," (col. 1, lines 64-66), whereas Fowler does not disclose or suggest any kind of multi-layer membrane, but rather discloses a personal cleansing product including active agent on or impregnated into a substrate. Claim 10, lines 2-3.

In addition, the mechanisms employed by Shlenker and Fowler for release of agents are fundamentally different. Fowler discloses that the substrate is configured to be mechanically agitated to provide a lather generating effect and also aid in the deposition of the conditioning component. Page 6, lines 8-10. The personal cleansing

product of Fowler is wetted with water and “lather is generated from the product by mechanically agitating and/or deforming the product either prior to or during contact of the product with the skin or hair.” Page 27, last paragraph. In contrast, there is no disclosure in Shlenker of providing any kind of agitation to facilitate the release of the agent. Therefore, both the structure and mechanisms employed by Shlenker and Fowler are fundamentally different, and thus, there is no motivation, suggestion, or teaching, in Shlenker, Fowler, or any other source, to provide the article of Shlenker with Fowler’s mechanism for release of an active agent.

For at least the foregoing reasons, the required motivation to combine or modify the applied references is lacking. As such, the Examiner fails to satisfy at least one essential criteria for establishing a *prima facie* case of obviousness. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 and the § 103(a) rejection of those claims should be reversed.

The combination of Shlenker and Fowler does not disclose or suggest all the recitations of claims 19-21, 23, and 24

Neither Shlenker nor Fowler nor any combination thereof discloses or suggests all the recitations of claims 19-21, 23, and 24. For example, as discussed above, the combination of Shlenker and Fowler does not disclose or suggest an adhesive matrix. Therefore, the combination of Shlenker and Fowler also fails to disclose or suggest “at least two adhesive matrices,” as recited in claims 19 and 20, or “a first adhesive matrix . . . [and] a second adhesive matrix,” as recited in claims 21 and 23. Thus, no *prima facie* case of obviousness has been established with respect to claims 19-21 and 23. Claim 24 depends from claim 21 and, therefore, no *prima facie* case of obviousness

has been established with respect to claim 24. For at least these reasons, the § 103(a) rejection of claims 19-21, 23, and 24 should be reversed.

The rejection of claim 44 under 35 U.S.C. § 103(a) should be reversed

The combination of Shlenker and Auguste does not disclose or suggest all the recitations of claim 44

The rejection, under 35 U.S.C. § 103(a), of claim 44, which depends from claim 1, fails to establish a *prima facie* case of obviousness for at least the reason that Auguste fails to remedy the above-mentioned deficiencies of Shlenker with respect to claim 1. The Office Action states that “Auguste is relied upon for the solely teaching [sic] of polyamide.” Office Action, page 13, line 10. However, regardless of whether Auguste teaches polyamide, Auguste does not remedy Shlenker’s failure to disclose or suggest an “adhesive matrix between . . . two non-adhesive layers,” “two non-adhesive layers being . . . bonded to [an] adhesive matrix,” or a “composite structure . . . configured so that when the composite structure is wetted by the solvent, the active agent is released from [an] adhesive matrix and diffuses towards [a] surface region,” as recited in claim 1, from which claim 44 depends. Therefore, the Examiner has not established that the applied art discloses or suggests all of the features of claim 44. Accordingly, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking and, for at least this reason, the § 103(a) rejection of claim 44 based on Shlenker and Auguste should be reversed.

There is no motivation, suggestion, or teaching to combine Shlenker and Auguste in a manner resulting in Appellant’s claimed invention

In addition to the fact that the Office Action does not show that the features of claim 44 can be found in some combination of Shlenker and Auguste, a case for *prima*

facie obviousness also has not been established with respect to these claims at least because the requisite motivation, suggestion, or teaching to combine the references is lacking. The Examiner alleges that

it would have been obvious to one having ordinary skill in the art . . . to provide the article disclosed by Shlenker . . . and add polyamide powder to the active agent containing layer as disclosed in Auguste, motivated by the teaching of Auguste that cosmetic comprising this powder has transfer resistance from the skin to the surfaces it comes in contact with.

Office Action at 12. Auguste discloses transfer-resistant make-up compositions including “lipsticks, solid or liquid foundations, mascaras, face powders, eyeshadows and other similar products, concealer products, antisen products, skin-coloring products or body hygiene products (in particular deodorants).” Col. 5, lines 63-67. The transfer-resistant quality of these compositions is provided by a combination of linear silicone and another cosmetic solvent that is more volatile than the linear silicone. Col. 1, lines 40-51; col. 2, lines 4-9. Therefore, the Examiner’s allegation that “cosmetic comprising this [polyamide] powder has transfer resistance” is inaccurate. Thus, contrary to the Examiner’s allegation, nothing supports alleging that merely adding the polyamide powder of Auguste to the agents in Shlenker would enhance the transfer resistance of such agents. Indeed, there is no motivation, suggestion, or teaching, in the applied references or any other source, to add the polyamide powder found in the cosmetic composition of Auguste to the agents disclosed in Shlenker.

Further, Shlenker discloses needle-treating biocides and lubricants (col. 1, lines 64-67; col. 5, lines 4-12), which are fundamentally different compositions from the make-up compositions of Auguste. Therefore, without the hindsight benefit of Appellant’s own disclosure, one of ordinary skill in the art would not have looked to

make-up compositions, such as those taught by Auguste, for ways to modify the needle-treating biocides and lubricants disclosed by Shlenker.

Furthermore, there is no motivation, suggestion, or teaching to apply a make-up composition by using the multi-layer membrane of Shlenker. Therefore, there is no motivation, suggestion, or teaching, in the applied references or any other source, to provide the make-up composition of Auguste in combination with Shlenker.

For at least the foregoing reasons, the required motivation to combine or modify the applied references is lacking. As such, the Examiner fails to satisfy at least one essential criteria for establishing a *prima facie* case of obviousness. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 44 and the § 103(a) rejection of that claim should be reversed.

The rejection of claims 12, 13, and 61-64 under 35 U.S.C. § 103(a) should be reversed

The combination of Shlenker and Yoko does not disclose or suggest all the recitations of claims 12, 13, and 61-64

The rejection of claims 12, 13, and 61-64 under 35 U.S.C. § 103(a) based on Shlenker in view of Yoko fails to establish a *prima facie* case of obviousness at least because neither reference, either alone or in combination, discloses or suggests each and every recitation of the claims.

The rejection, under 35 U.S.C. § 103(a), of claims 12 and 13, which depend from claim 1, fails to establish a *prima facie* case of obviousness for at least the reason that Yoko does not remedy the above-mentioned deficiencies of Shlenker with respect to claim 1. The Office Action states that “[Yoko] is relied upon for the solely teaching [sic] of magnetic particles.” Office Action, page 15, line 13. However, regardless of whether

or not Yoko teaches magnetic particles, Yoko does not remedy Shlenker's failure to disclose or suggest an "adhesive matrix between . . . two non-adhesive layers," "two non-adhesive layers being . . . bonded to [an] adhesive matrix," and a "composite structure . . . configured so that when the composite structure is wetted by the solvent, the active agent is released from [an] adhesive matrix and diffuses towards [a] surface region," as recited in claim 1, from which claims 12 and 13 depend. Therefore, the Examiner has not established that the applied art discloses or suggests all of the features of claims 12 and 13. Accordingly, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking and, for at least this reason, the § 103(a) rejection of claims 12 and 13 based on Shlenker and Yoko should be reversed.

Furthermore, Shlenker does not disclose or suggest a composite structure including, among other things, an "adhesive matrix between . . . two support layers," or "two support layers being . . . bonded to [an] adhesive matrix," as recited in independent claim 61. Yoko, cited only for an alleged teaching of magnetic particles, does not correct the above-noted deficiencies of Shlenker, with respect to claim 61. Thus, for at least this reason, a case of *prima facie* obviousness has not been established with respect to claim 61 or with respect to claims 62-64, which depend therefrom. Accordingly, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking and, for at least this reason, the § 103(a) rejection of claims 61-64 based on Shlenker and Yoko should be reversed.

There is no motivation, suggestion, or teaching to combine Shlenker and Yoko in a manner resulting in Appellant's claimed invention

In addition to the fact that the Office Action does not show that the features of claims 12, 13, and 61-64 can be found in some combination of Shlenker and Yoko, a case for *prima facie* obviousness also has not been established with respect to these claims at least because the requisite motivation, suggestion, or teaching to combine the references is lacking.

The Examiner acknowledges that Shlenker "does not teach the magnetizable particles." Office Action at 14. The Examiner attempts to remedy this deficiency by applying Yoko, which discloses a magnetic cosmetic. The Examiner alleges that

it would have been obvious . . . to provide the article disclosed by [Shlenker] . . . and add magnetizable particles to the active agent containing layer as disclosed by [Yoko], motivated by the teaching of [Yoko] that magnetizable particles are capable of promoting the blood flow to the skin without causing its inflammation.

Office Action at 14. However, Shlenker discloses articles including agents, such as biocides and lubricants (Col. 1, lines 64-67), for treating needles (col. 4, line 5; col. 5, line 30), not skin. Therefore, without the hindsight benefit of Appellant's own disclosure, one of ordinary skill in the art would not have looked to the magnetic cosmetic of Yoko for ways to modify the needle-treating biocides and lubricants disclosed by Shlenker.

In addition, as discussed above with regard to claim 44, there is no motivation, suggestion, or teaching, in the applied references or any other source, to apply a cosmetic through a membrane. Therefore, for the same reasons it would not have been obvious to provide the cosmetic composition of Auguste, or a component thereof, in the article of Shlenker, it would not have been obvious to include the cosmetic of Yoko in the article of Shlenker.

For at least the foregoing reasons, the required motivation to combine or modify the applied references is lacking. As such, the Examiner fails to satisfy at least one essential criteria for establishing a *prima facie* case of obviousness. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 12, 13, and 61-64 and the § 103(a) rejection of that claim should be reversed.

The combination of Shlenker and Yoko does not disclose or suggest all the recitations of claim 64

In addition to failing to disclose or suggest all the recitations of independent claim 61, from which claim 64 depends, neither Shlenker nor Yoko nor any combination thereof discloses or suggests all the recitations of claim 64. As discussed above, with respect to claims 1 and 54-56, Shlenker does not disclose or suggest a "composite structure configured so that when the composite structure is wetted by [a] solvent, [an] active agent is released from [an] adhesive matrix and diffuses towards [a] surface region," as recited in claims 1 and 54-56. Claim 64 includes this same recitation. Therefore, Shlenker fails to disclose or suggest all the recitations of claim 64 as well. Yoko, cited only for a teaching of a magnetic cosmetic, fails to remedy this deficiency of Shlenker. Thus, no *prima facie* case of obviousness has been established with respect to claim 64. For at least these reasons, the § 103(a) rejection of claim 64 should be reversed.

Conclusion

For the reasons given above, the Section 102(b) and 103(a) rejections applied to pending claims 1, 5-30, and 35-65 should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 28, 2006

By: 

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Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. (Previously Presented) A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent and configured to be placed into contact with the surface region; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

Claims 2-4 (Canceled).

5. (Previously Presented) A composite structure according to claim 1, wherein said solvent comprises water.

6. (Original) A composite structure according to claim 1, wherein the matrix contains at least one water-soluble active agent.

7. (Previously Presented) A composite structure according to claim 1, wherein the matrix comprises at least one moisture-absorbing compound.
8. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains 0.2% to 60% by weight of a moisture-absorbing compound.
9. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix includes at least one moisture-absorbing compound chosen from polyacrylates, silicas, cotton fibers, starches, alginates, calcium carbonates, magnesium, viscose, cellulose, and freeze-dried substances.
10. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix comprises at least one substantially inert substance.
11. (Previously Presented) A composite structure according to claim 1, wherein the active agent is chosen from vitamin C, vitamin A, vitamin F, glycerin, laponite, wetting agents, collagen, salicylic acid, tio acid, caffeine, aromatic essential oils, coloring agents, anti-oxidants, free radical scavengers, moisturizers, depigmenting agents, liporegulators, anti-acne agents, antidandruff agents, anti-aging agents, softeners, antiwrinkle agents, keratolytic agents, anti-inflammatory agents, fresheners, healing agents, vascular protectors, antibacterial agents, antifungal agents, antiperspirants, deodorants, skin conditions, anesthetics, immunomodulators, and nourishing agents.
12. (Original) A composite structure according to claim 1, wherein the adhesive matrix includes magnetizable particles.

13. (Original) A composite structure according to claim 12, including at least two layers of magnetizable particles capable of generating respective magnetic fields of different polarities.

14. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix comprises a permanent adhesive comprising one of vinyl, PVA, PVP, pseudo-latex, an acrylic polymer, a polyurethane, and a latex elastomer.

15. (Previously Presented) A composite structure according to claim 1, wherein at least one of the two layers comprises a non-woven fabric.

16. (Previously Presented) A composite structure according to claim 1, wherein the at least two layers are permeable to the solvent.

17. (Previously Presented) A composite structure according to claim 16, wherein said at least two layers have at least one of different roughnesses, different porosities, and different thicknesses so as to enable two different types of application to be performed depending on a face of the layer selected by the user for application.

18. (Previously Presented) A composite structure according to claim 1, including an impermeable layer.

19. (Previously Presented) A composite structure according to claim 1, wherein the composite structure comprises at least two adhesive matrices of identical compositions, the at least two adhesive matrices being one of juxtaposed and superposed.

20. (Previously Presented) A composite structure according to claim 19, wherein said at least two adhesive matrices are stuck to each other and include different active agents.

21. (Previously Presented) A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix containing at least one active agent, a second support layer, and a second adhesive matrix essentially covered by a removable protective film.

22. (Previously Presented) A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix containing at least one active agent, a second support layer, a second adhesive matrix containing at least one active agent, and a third support layer, the second support layer being impermeable and the first and third support layers being permeable, the first and second adhesive matrices containing different active agents.

23. (Previously Presented) A composite structure according to claim 1, comprising a superposition of layers comprising, in order, a first support layer, a first adhesive matrix, a second adhesive matrix, and a second support layer.

24. (Original) A composite structure according to claim 21, wherein the first and second adhesive matrices have respective active agents that need to be stored separately.

25. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix comprises two juxtaposed regions containing different active agents.

26. (Previously Presented) A composite structure according to claim 25, wherein the adhesive matrix is a first adhesive matrix, and wherein the structure further includes a second adhesive matrix comprising two juxtaposed regions containing different active agents, the active agents contained in the second adhesive matrix being different from those of the adhesive matrix.

27. (Previously Presented) A method of manufacturing a composite structure for at least one of cleaning, treating, and making up a surface region, the method comprising:

coating a first non-adhesive layer with an adhesive matrix comprising a permanent adhesive, said adhesive matrix containing at least one active agent, the active agent being released when the composite structure is wetted by a solvent; and

assembling together the coated first non-adhesive layer with a second non-adhesive layer such that the adhesive matrix is sandwiched between the first non-adhesive layer and the second non-adhesive layer and such that one of the first and second non-adhesive layers is configured to be placed into contact with the surface region, the first non-adhesive layer and the second non-adhesive layer being permanently bonded together by the adhesive matrix.

28. (Previously Presented) A method according to claim 27, further comprising coating the second layer on one face with a second adhesive matrix.

29. (Original) A method according to claim 28, wherein the two adhesive matrices are stuck together.

30. (Previously Presented) A method according to claim 27, wherein a large quantity of layers coated in adhesive matrices containing predetermined active agents

are manufactured separately, and wherein the various layers coated in this way are assembled together to make up a range of composite structures presenting different combinations of active agents.

Claims 31-34 (Canceled).

35. (Previously Presented) A pile of composite structures, comprising at least two composite structures as defined in claim 1, one of the two layers of each composite structure having an adhesive face in contact with an underlying composite structure and having an extension enabling the pile of composite structures to be taken hold of by a user.

36. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the additional active agent more easily.

37. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent soluble in the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the additional active agent more easily.

38. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains at least one additional active agent soluble in the solvent and configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the active agent more easily.

39. (Previously Presented) A composite structure according to claim 1, wherein the at least one active agent is configured to swell when contacted by the solvent, the adhesive matrix containing a sufficient quantity of the at least one additional active agent such that the adhesive matrix loses cohesion on contact with the solvent and releases the active agent more easily.

40. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains a filler comprising at least one compound configured to swell on contact with the solvent, the adhesive matrix containing a sufficient quantity of the at least one compound such that the matrix loses its cohesion on contact with the solvent and releases the active agent more easily.

41. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix contains a filler comprising at least one substantially inert compound, the adhesive matrix containing a sufficient quantity of the at least one compound such that the matrix loses its cohesion on contact with the solvent and releases the active agent more easily.

42. (Previously Presented) A composite structure according to claim 8, wherein the adhesive matrix contains 0.5% to 40% by weight of the moisture-absorbing compound.

43. (Previously Presented) A composite structure according to claim 10, wherein the at least one substantially inert substance comprises one of microbeads of an inert compound and powder of an inert compound.

44. (Previously Presented) A composite structure according to claim 43, wherein the powder of an inert compound comprises a polyamide powder.

45. (Previously Presented) A composite structure according to claim 1, wherein the composite structure comprises at least two adhesive matrices of at least two different compositions, the at least two adhesive matrices being one of juxtaposed and superposed.

46. (Previously Presented) A composite structure according to claim 45, wherein said at least two adhesive matrices are stuck to each other and include different active agents.

47. (Previously Presented) A method of applying a patch to skin, comprising:
applying a patch to the skin for a predetermined length of time, wherein the patch comprises the composite structure as defined in claim 1.

48. (Previously Presented) A method of cleaning skin, comprising:
contacting the skin with the composite structure as defined in claim 1.

49. (Previously Presented) A method of treating hair, comprising:
contacting the hair with the composite structure as defined in claim 1.

50. (Previously Presented) A composite structure according to claim 1, wherein the adhesive matrix comprises an active agent reservoir, and wherein the composite structure may be re-wetted at least once.

51. (Previously Presented) A composite structure according to claim 1, wherein the at least one adhesive matrix comprises a single layer of adhesive matrix.

52. (Previously Presented) A composite structure according to claim 51, wherein the single layer contacts the at least two non-adhesive layers.

53. (Previously Presented) A composite structure according to claim 51, wherein a second layer of adhesive matrix contacts one of the at least two non-adhesive layers.

54. (Previously Presented) A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, and

wherein the structure is configured such that the adhesive matrix does not come into contact with the surface region.

55. (Previously Presented) A composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising:

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent; and

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region, and

wherein the composite structure does not adhere to the surface region before being wetted by the solvent.

56. (Previously Presented) A composite structure for at least one of treating, making up, and cleaning a surface region of the human body, the composite structure comprising:

at least two support layers, at least one of the two support layers being permeable to a solvent, said support layers forming external faces of the structure; and

at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix, the adhesive matrix containing at least one active agent that is soluble in said solvent,

wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

57. (Previously Presented) A composite structure according to claim 56, wherein the adhesive matrix is in contact with said two support layers.

58. (Previously Presented) A composite structure according to claim 56, comprising two adhesive matrices stuck together and sandwiched between the two support layers.

59. (Previously Presented) A composite structure according to claim 56, wherein the composite structure is configured to be capable of adhering to the surface region of the human body.

60. (Previously Presented) A composite structure according to claim 56, wherein the solvent comprises water.

61. (Previously Presented) A composite structure for at least one of treating, making up, and cleaning a surface region of the human body, the composite structure comprising:

at least two support layers; and

at least one adhesive matrix between the two support layers, the two support layers being permanently bonded to the adhesive matrix, said adhesive matrix further comprising magnetizable particles.

62. (Previously Presented) A composite structure according to claim 61, wherein at least one of the two support layers is permeable to a solvent.

63. (Previously Presented) A composite structure according to claim 62, wherein the adhesive matrix contains at least one active agent that is soluble in said solvent.

64. (Previously Presented) A composite structure according to claim 63, wherein the composite structure is configured so that when the composite structure is wetted by the solvent, the active agent is released from the adhesive matrix and diffuses towards the surface region.

65. (Previously Presented) A composite structure according to claim 1, wherein the composite structure is configured to treat an exterior body surface with the active agent.

Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

None.

Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

There are no decisions from related proceedings.